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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/764,308	01/19/2001	Takanori Terada	1046.1232/JDH	6758
21171	7590	04/27/2007	EXAMINER	
STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			MANIWANG, JOSEPH R	
			ART UNIT	PAPER NUMBER
			2144	
SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE		
3 MONTHS	04/27/2007	PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/764,308	TERADA, TAKANORI	
	<b>Examiner</b>	<b>Art Unit</b>	
	Joseph R. Maniwang	2144	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### **Status**

- 1) Responsive to communication(s) filed on 09 February 2007.
- 2a) This action is **FINAL**.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### **Disposition of Claims**

- 4) Claim(s) 1,2,4-6,8-11,13-15,17-20,22-24,26 and 27 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1,2,4-6,8-11,13-15,17-20,22-24,26 and 27 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### **Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### **Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### **Attachment(s)**

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application
- 6) Other: \_\_\_\_\_.

**DETAILED ACTION**

1. The application has been assigned to another examiner. New contact information is listed below.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

***Claim Rejections - 35 USC § 103***

3. Claims 1-2, 4-6, 8-11, 13-15, 17-20, 22-24, 26, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 6,721,785 by Raghunandan and US Patent No. 7,039,639 by Brezin et al in view of US Patent No. 6,574,671 by Haynes.
4. In claim 1, Raghunandan teaches about an E-mail device comprising (Fig 2): a first detection module (program that link alias to recipient email addresses) of detecting that a plurality of multicast target mail destination addresses exist in a stored mail delivery history (Alias are stored in advance to reduce the burden of entering individual email, Col 1, line 65-Col 2, line 5; Col 4, lines 48-55); an adding module ("inclusion directive") of adding the group name corresponding to the plurality of multicast target mail destination addresses of the destination attribute to group management information (Col 5, lines 45-60); and a generating module (the function of defining the recipient of the email message) of executing a process of generating a group formed of the plurality of multicast target mail destination addresses (" alias41 .... Alias4n") corresponding to the detection

(Alias or grouping is done to associate a plurality of email addresses that have the same characteristic or attribute, Col 5, lines 60-67; Col 6, lines 10-20; Col 2, lines 1-5).

5. Raghunandan does not explicitly teach the group generating process being done using all destination attributes nor a setting module setting an input count of the mail destination addresses in the history in order to register the added group name.

6. Haynes teaches about a simpler generation process that generates a group base on all the destination attributes ("To", "BCC", and "CC", Col 5, lines 30-60). The approach of Raghunandan generates a group base on n number of groups alias, and with n being a large number, a large amount of overhead processing power is required to generate a group (Col 6, lines 5-35). The group is created prior to the mail being delivered. The less granular approach of Haynes requires less processing which reduces the time taken before mail delivery. Raghunandan teaches about creating a group base on recipients that are frequently contact. To determine which recipients are frequently contacted, there has to be an element of counting. Brezin et al teaches about a simple frequency count in optimizing user behavior (Col 3, lines 50-65).

7. It would have been obvious at the time of the invention for some of ordinary skill to improve on the time taken to delivery a mail in Raghunandan invention by using the less granular approach of Haynes invention while optimizing the grouping process of Raghunandan using the counting approach of Brezin et al.

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8. In claim 2, Raghunandan and Brezin combined with Haynes, teaches about the E-mail device according to claim 1, further comprising a second detection module detecting that there does not exist a group corresponding to the plurality of multicast target mail destination addresses existing in the history (detection module- i.e. the function that determine that a selection command is active, which indicates that a intended group is not available and therefore has to be created base on the accompanying directives, Raghunandan, Col 5, lines 35-60); wherein if there does not exist a group corresponding to the plurality of multicast target mail destination addresses, said generating module generates the group (Raghunandan, Col 5, lines 45-60).

9. In claim 4, Raghunandan and Brezin combined with Haynes, teaches about the E-mail device according to claim 1, wherein said adding module includes a providing module registering the added group name corresponding to the plurality of multicast target mail destination addresses (This is function that is used when creating alias, Raghunandan Col 4, lines 48-55).

10. In claim 5, Raghunandan and Brezin combined with Haynes, teaches about the E-mail device according to claim 4, wherein said adding module further includes a first registering module registering the added group name inputted by a user in the group management information in the registering the added group name "alias" (Raghunandan, Col 1, line 65- Col 2, line 5).

11. In claim 6, Raghunandan and Brezin combined with Haynes, teaches about the E-mail device according to claim 5, wherein said adding module further includes a second registering module registering a piece of registration reject

state information in the group management information when the user rejects the registration of the added group name in the registering the added group name (the exclusion directive that remove names from the final list, Raghunandan Col 3, lines 30-40).

12. In claim 8, Raghunandan and Brezin combined with Haynes, teaches about the E-mail device according to claim 1, wherein said adding module generates the group name by a predetermined algorithm "rules" and adds this group name to the group management information (Raghunandan, Col 5, lines 45-60).

13. In claim 9, Raghunandan and Brezin combined with Haynes, teaches about an E-mail device according to claim 1, further comprising a selecting module "selection command" of enabling the user to select whether the process of generating the group is to be executed or not (Raghunandan, Col 5, lines 45-60).

14. Claims 10-11, 13-15 and 17-18 are the method to the device of claims 1-2, 4-6 and 8-9 respectively and are rejected for the same reason. Claims 19-20, 22-24 and 26-27 are the readable computer medium, which stores the executable program that execute the method to the device of claims 1-2, 4-6 and 8-9 respectively and are rejected for the same reason.

#### **Response to Arguments**

15. Applicant's arguments filed 02/09/07 have been fully considered but they are not persuasive.

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16. Applicant asserts that the prior art of record fails to teach “an input count of the mail destination addresses is set in the history in order to register the added group name when the input count reaches a predetermined number” as claimed in independent claims 1, 10, and 19. Applicant argues that in contrast to the prior art, the present invention allows a user to “change and set the predetermined count, and a group name is registered, automatically, when the input count reaches the predetermined number”. Examiner submits that the claim language does not necessarily recite such a feature. In fact, it is noted that the features upon which applicant relies (i.e., setting a predetermined count) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The claim language instead recites “setting an input count”, and adding a group name “when the input count reaches a predetermined number.” This is vastly different from setting a predetermined number and adding a group when an input count reaches the set predetermined number. Additionally, it is unclear from the claim language by what mechanism a group name is automatically registered when an input count reaches a predetermined number. Broadly, the claimed setting of an input count is merely for the purpose for (i.e., “in order to”) register(ing) a group name. However, the claim language does not require the actual registration of a group name, nor doing so automatically. It is reiterated that the prior art reference Brezin discloses the creation of a group based on a frequency count for a number of different communication events (see column 3, lines 50-65).

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Brezin thus reads on the claimed "input count", which is not specifically limited at all by the claims as to what might be considered an input count.

17. Applicant further asserts that Haynes does not teach "said group capable of including destination addresses of various destination attributes", arguing that Haynes teaches that a group represents a particular characteristic (see column 5, lines 38-42). Examiner submits that the "various destination attributes" is not limited by the claims to include anything specific. Haynes clearly teaches a group having multiple destination attributes, as Haynes allowed for individual addresses of a group (e.g., "list") to have different characteristics (see column 5, lines 23-29). Haynes thus reads on the broad concept of a group of destination addresses having various destination attributes as claimed.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will

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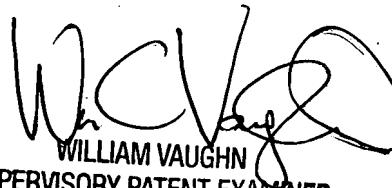
the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph R. Maniwang whose telephone number is (571) 272-3928. The examiner can normally be reached on Mon-Fri 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William C. Vaughn can be reached on (571) 272-3922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JM



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